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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,793	10/27/2003	Eugene M. Lee	113708.129US1	1059

23400 7590 04/03/2012

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ART UNIT	PAPER NUMBER
2177	

NOTIFICATION DATE	DELIVERY MODE
04/03/2012	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/692,793	LEE ET AL.	
	Examiner	Art Unit	
	QUOC A. TRAN	2177	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 December 2008 and BPAI on 09/02/2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) *1-3,6-10,13-18,20-28 and 54* is/are pending in the application.

5a) Of the above claim(s) *29-53* is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *1-3,6-10,13-18,20-28 and 54* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☒ The drawing(s) filed on *12/05/2008* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This is a Non-Final Office Action in responses to Applicant's Appeal Brief filed 12/05/2008 and BPAI decision "Affirmed in part" dated 09/02/2011. Claims 1-3, 6-10, 13-18, 20-28 and 54 are pending. Claims 1, 18 and 25 are independent claims. Claims 4-5, 11-12, and 19 were canceled. Claims 29-53 have been withdrawn from consideration [Non-elected claims].

It is noted; the prosecution on the merits of this application is reopened on claims 1-3, 6-10, 13-18, 20-28 and 54 considered unpatentable for the reasons indicated in the followings:

Claim Rejections - 35 USC § 112

Claims 7, 18, 20-24 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because of the following reason:

It is noted Claim 18 recites the limitations said, "(A) at least one **merge** component… (B) At least one **split** component…" REPECTIVELY, whereas the original disclosure Pg.33, lines 4-6, which is stated, "…In the illustration of FIG. 3, a document with annotations is **split** into data streams via annotation split 305, **and merged** into an annotated document via annotation merge 307…" which failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Also Claim 7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because of the similar reason as recited above.

In addition, dependent Claims 20-24 and 54 merely further include additional components and/or functionality of the "*annotating"* of the electronic documents. Thus Claims 20-24 and 54 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because of the similar reason as recited above.

Moreover, claims 7, 18, 20-24 and 54 are rejected under 35 U.S.C. 112, second paragraph, because there is insufficient antecedent basis for this limitation in the claim:

It is noted Claim 18 recites the limitations said, "…to update the at least one annotation in the first data storage….. to update the at least one document in the second data storage…" whereas limitation (A) indicates that the document is stored in the 1st data storage, and not in the second, and that the annotation is stored in the 2nd data storage, and not in the first as recited above. There is insufficient antecedent basis for these limitations in the claim.

Also Claim 7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because of the similar reason as recited above.

In addition, dependent Claims 20-24 and 54 merely further include additional components and/or functionality of the "*annotating"* of the electronic documents. Thus Claims 20-24 and 54 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because of the similar reason as recited above.

In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejections under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 6, 8-10, 13-17 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rivette'137** et al. US006877137B1- filed 12/07/1999 [hereinafter Rivette'137], in view of **Eintracht** et al. US006687878B1- filed 03/15/1999 [hereinafter Eintracht].

Regarding ***independent claim 1,***

Rivette'137 teaches:

A computer-implemented system for providing annotated electronic documents, said system comprising: an annotation component configured to determine, responsive to at least one user, at least one annotation to be applied to at least one document, including a selection resource to select at least a portion of the at least one document and to associate the at least one annotation therewith.

Specifically Rivette'137 discloses web annotation system (item 502 Fig. 5) the plurality components (items 504-509, fig. 5) for Web annotation (Rivette'137, col. 13, lines 5-10).

In addition Rivette'137 discloses user interface (item 504, fig. 5) creates, updates, and deletes objects in the Web annotation system 502 preferably using the COM interfaces (Rivette'137, col. 17, lines 10-20).

Furthermore Rivette'137 discloses web annotation system using Component Object Model, Jscript or DHTML component for controlling annotation system. Whereby enable a user to create an annotation to a web page, and links the annotation to the selected portion (Rivette'137 at col. 4, line 60 through col. 5 and Fig. 10 items 502, 1014A, 1016A and 1020A-1022B).

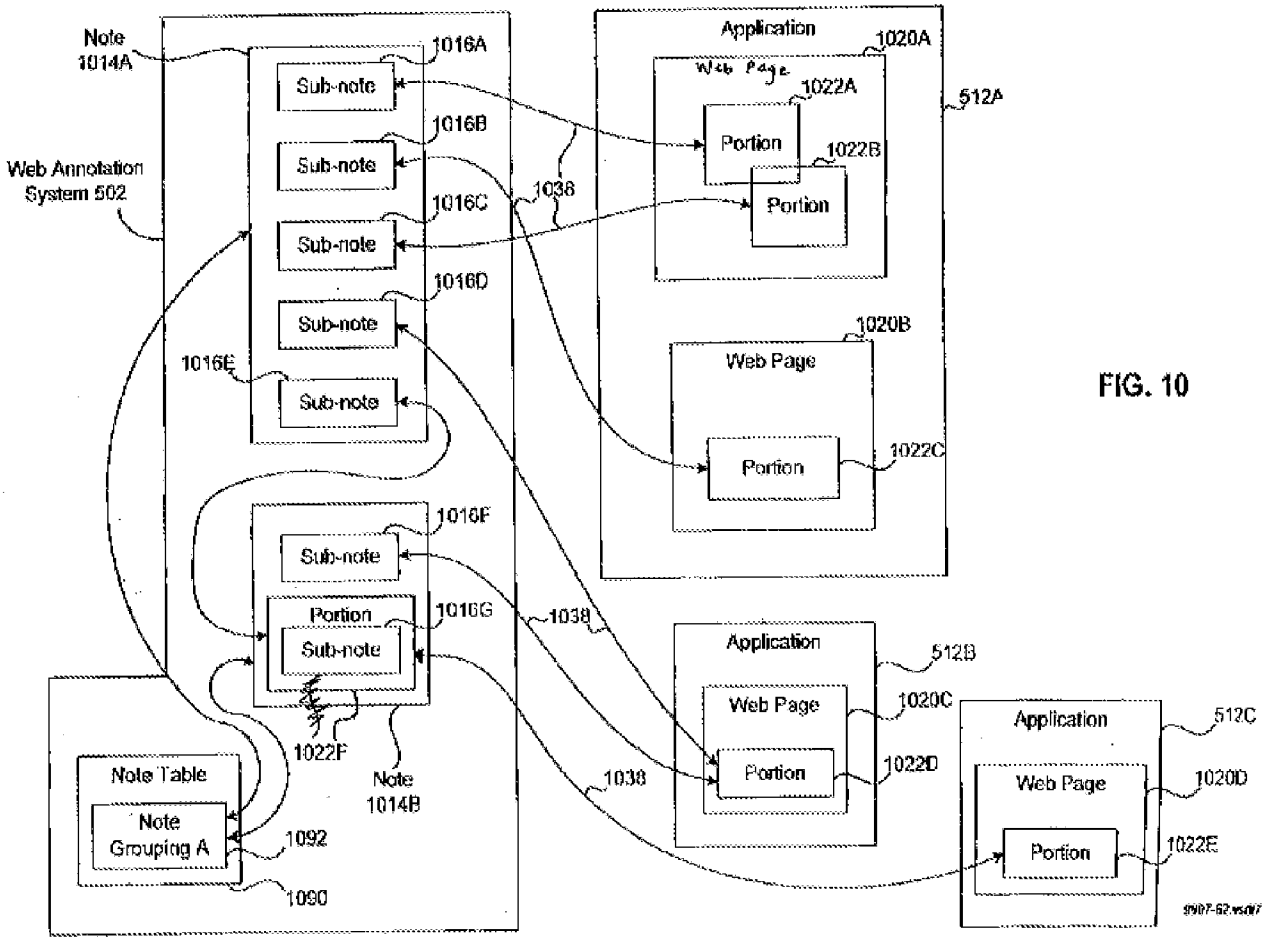

FIG. 10

Furthermore Rivette'137 teaches:

The annotation is image data or text, wherein each annotation can be different from every other annotation;

For example, Rivette'137 discloses in FIG. 5 the Web annotation system 502, includes a Web page's images or its text (see Rivette'137 Column 11, Lines 40-45).

Also, See Rivette'137, Column 7, Lines 45-55, teaches product (CPP) for attaching annotations (or notes and sub-notes) to different data object portions as required by the needs of the user.

Also Rivette'137 teaches:

a reference component, responsive to the at least one user, configured to at least one of establish, traverse, indicate, and remove, at least one reference between the at least one portion and at least one of another portion of the at least one document, another document, and at least one other portion of the other document.

Specifically Rivette'137 discloses a user interface for accessing and traverse the function provides by the web annotation system item 502 (Rivette'137, col. 31, lines 5-25). Also Rivette'137 discloses portions of Web pages can be stored at a Web site or in a local file system. The method of linking notes to web pages operates by enabling a user to select a portion of a Web page, creating a annotation, linking the annotation to the selected portion, receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, and for

causing the application to load the Web page and present the selected portion (Rivette'137 at the Abstract).

In addition Rivette'137 teaches:

a mark-up resource to at least one of add and edit the at least one annotation.

For example Rivette'137 discloses creating an annotation, linking the annotation to the selected portion, receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, and for causing the application to load the Web page and present the selected portion (Rivette'137 at the Abstract).

Moreover Rivette'137 teaches:

to retrieve at least one document from the first data storage as document data.

For example Rivette'137 discloses portions of Web pages can be stored at a Web site or in a local file system (Rivette'137 at the Abstract).

In addition Rivette'137 teaches:

to retrieve the at least one annotation be applied to said at least one document from a second storage as annotation data.

Specifically Rivette'137 discloses notes can be grouped together under one note grouping, note table (item 1090) or other database construct is used to keep track of which notes are in which note groupings (Rivette'137 at col. 18, lines 55-60 fig. 10 item 502 and 1090). Conceptually, note repository object 804, note object 806, sub-note object 808, content object 810, and anchor object 812 make up the notes database 508 (FIG. 5). Likewise, Web page repository object 814, Web page folder object 816, and Web page object 818 conceptually make up Web pages database 509 (Rivette'137 at col. 17, lines 7-11).

Also Rivette'137 teaches:

the annotations which are to be applied to the documents being stored in a first data storage, the documents being stored in a second data storage, the first data storage and the second data storage being at least one of physically separate and logically separate,

For example Rivette'137 discloses portions of Web pages can be stored at a Web site or in a local file system (Rivette'137 at the Abstract). Also, Rivette'137 further discloses notes can be grouped together under one note grouping, note table (item 1090) or other database construct is used to keep track of which notes are in which note groupings (Rivette'137 at col. 18, lines 55-60 fig. 10 item 502 and 1090). Conceptually, note repository object 804, note object 806, sub-note object 808, content object 810, and anchor object 812 make up the notes database 508 (FIG. 5). Likewise, Web page

repository object 814, Web page folder object 816, and Web page object 818 conceptually make up Web pages database 509 (Rivette'137 at col. 17, lines 7-11).

In addition, Rivette'137 does not explicitly teach, but

Eintracht teaches:

at least one merge component configured to combine the annotation:

(See Eintracht at Fig. 3, and 8 and at Column 15, Line 60→Column 16, Line 10, discloses the annotation Session: includes synchronization of notes and merges the note event information with the server and/or local Notes Database.)

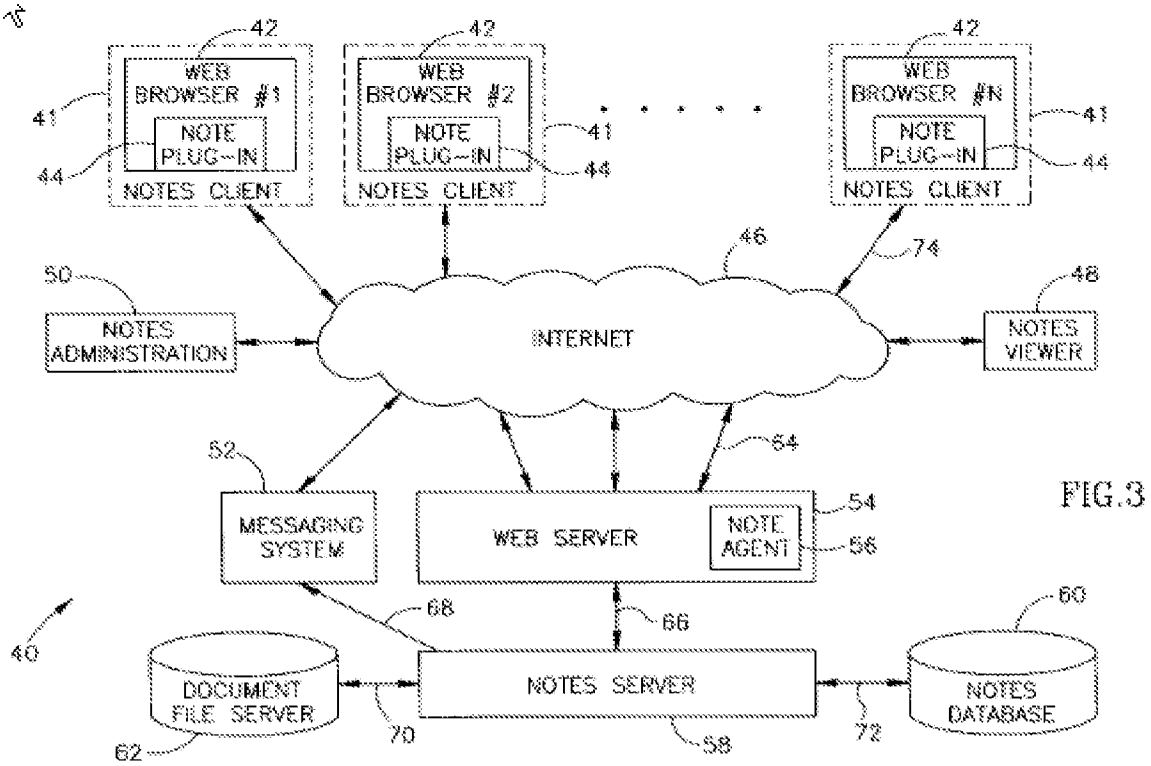

FIG.3

combine the annotation data and the document data to form a unitary single logical document, the single logical displaying the annotation data embedded seamlessly in the document data,

(See Eintracht at Fig. 3, and 8 and at Column 15, Line 60→Column 16, Line 10, discloses the annotation Session: includes synchronization of notes and merges the note event information with the server and/or local Notes Database.

Also See Eintracht at Column 2, Lines 15- 55, further discloses a notes client/server notes databases (i.e. notes markup resources), that includes the client software application, which is implemented as a web browser plug-in module. The plug-in contains the user interface for navigating *within the document and for handling the notes*. This allows the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each. This allows the notes merge and the notes are combined with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

Using the broadest reasonable interpretation, the Examiner reads the claimed ***unitary single logical document, and annotation data embedded seamlessly in the document data*** as equivalent to the client application layers the annotations over the image (or document) in accordance with the coordinates of each using the synchronization of notes process as taught by Eintracht. This interpretation is supported

by the Applicant's disclosure, which states, "*The annotation merge component 307 issues a request to retrieve these two (or more) documents. Consider that one of these, for illustration purposes, is a patent document and the other is annotation data marking up the patent "* [See Applicant's Specs at Page 33 Lines 13-18].)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Rivette'137, to include at least one merge component configured to combine the annotation data and the document data to form a unitary single logical document, the single logical displaying the annotation data embedded seamlessly in the document data as taught by Eintracht, to archive a predictable result of combining the notes with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

Regarding ***independent claim 25***,

the rejection of claim 1 is fully incorporated, similarly rejected along the same rationale. In addition Rivette'137 teaches:

in the computer system and in responsive to user.

Specifically Rivette'137 discloses a web annotation system (item 502 Fig. 5) the plurality components (items 504-509, fig. 5) for Web annotation (Rivette'137, col. 13, lines 5-10). In addition Rivette'137 discloses user interface (item 504, fig. 5) creates, updates, and deletes objects in the Web annotation system 502 preferably using the COM interfaces (Rivette'137, col. 17, lines 10-20).

Using the broadest reasonable interpretation, the examiner equates, the claimed **in responsive to user in the computer system** to Rivette'137 suggests of the user interface of fig. 10 of Rivette'137.

Claim 2,

Rivette'137 teaches:

a view component operatively connected to the annotation to edit, responsive to the at least one user, the at least one portion of the at least one document selected by the selection resource.

Specifically Rivette'137 discloses a web annotation system (item 502 Fig. 5) the plurality components (items 504-509, fig. 5) for Web annotation (Rivette'137, col. 13, lines 5-10). In addition Rivette'137 discloses user interface (item 504, fig. 5) creates, updates, and deletes objects in the Web annotation system 502 preferably using the COM interfaces (Rivette'137, col. 17, lines 10-20).

Claim 3,

Rivette'137 does not expressly teach, but Eintracht teaches:

display the single logical document as a representation of the at least one document.

(See Eintracht at Column 2, Lines 15- 55, further discloses a notes client/server notes databases (i.e. notes markup resources), that includes the client software application, which is implemented as a web browser plug-in module. The plug-in contains the user

interface for navigating *within the document and for handling the notes*. This allows the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each. This allows the notes merge and the notes are combined with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Rivette'137, to include a means of display the single logical document as a representation of the at least one document as taught by Eintracht, to archive a predictable result of combining the notes with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

Claim 6,

Rivette'137 teaches:

the document data and the annotation data is at least one of: XML format, binary format, image data, video data and audio data.

For example Rivette'137 discloses each sub-note includes a content data that which can be any format or combination of formats, such as text, sound, video, image, executable program, tactile, etc. (Rivette'137, col. 18, lines 10-30).

Claim 8,

Rivette'137 teaches:

wherein the at least one annotation indicates an evaluation of at least one legal property relative to the at least one document.

(See Rivette'137 Column 39, lines 5-25, discloses the related projects, such as licensing studies, litigation efforts, opinions of counsel (such as patentability, patent validity, and patent infringement studies); (2) scientific and/or engineering related projects, such as research and development projects; (3) electronic text books, handbooks, user manuals, encyclopedias, and other electronic reference works, including multimedia reference works; (4) auditory and visual documents; (5) virtual library; (6) review course, such as legal bar review course, business review courses, CPA courses, medical review courses, etc.; (7) virtual classrooms; (8) business-related Internet to research; and (9) casual Internet use.)

Claim 9,

Rivette'137 teaches:

at least one version component, configured to at least one of manage a history of changes and maintain at least one separate version for the at least one document and the at least one annotation applied thereto.

(See Rivette'137 Fig. 30 Column 29, Lines 55-65, discloses notes database 508 that stores Notes A, B, and C. As described above with reference to FIG. 8, the user interface 504 (FIG. 5) creates, updates, and deletes objects in the Web annotation system 502 preferably using the COM interfaces.)

Also, see Rivette'137 Column 22, Lines 25-40, a notes directory tree or a Web pages directory tree displayed in the notes/Web page directory window 1212, searching for a note or sub-note (as described above with the search button 1230), loading the original Web page (function that shows the user the original version of the Web page).)

Claim 10,

Rivette'137 teaches:

> **at least one schema configured to identify at least one tag in at least one of the at least one portion, the at least one document, and the at least one annotation**.

(See Rivette'137 Column 18, Lines 10-30, discloses Linking Sub-Notes To Web Pages allows users to link sub-notes to portions of data object, preferably Web pages, wherein a Web page (or data object) represents any information in any form that can be accessed and/or processed by a computer via the Internet (i.e. such as text files, image files, video files, audio files, computer programs, HTML documents, etc. Accordingly, these Web pages are disparate in both form and content. It is noted the claimed "*schema*" is wherein a Web page (or data object) represents any information in any form that can be accessed and/or processed by a computer via the Internet (i.e. such as text

files, image files, video files, audio files, computer programs, HTML documents, etc. as taught by Rivette'137.)

Claim 13,

Rivette'137 teaches:

> **the at least one annotation being associated with the at least one user, the at least one document being accessible by the plurality of users including the at least one user, and wherein the merge component is further configured, responsive to a request for the at least one document from the at least one, to limit the annotation data included in. the single logical document to annotations associated with the at learnt one user**.

(See Rivette'137 Column 14, Lines 60-67, discloses a user to select a portion of a Web page stored at a Web site or from a local file system (if the portion of the Web page was cached), and links the annotation to the selected portion. The invention receives a request from a user viewing the annotation to display the selected portion linked to the annotation. In response to this request, the invention makes a connection to the Web site, if a connection is not already created, and causes the Web site to send the Web page and present the selected portion. Also note that if the portion of the Web page was cached and thus stored in a local file system, then the present invention does not need to make a connection to a Web site.)

Claims 14 and 27,

the rejection of claims 1 and 25 are fully incorporated, and similarly rejected along the same rationale. In addition Rivette'137 teaches:

at least one annotation includes at least one of: a pre-defined notation, a user-provided text, a user-defined attribute, a reference to a URL, and a reference to one other file.

For example Rivette'137 discloses a web annotation system (item 502 Fig. 5) the plurality components (items 504-509, fig. 5), includes a web page's image and its text, that are associated with notes stores in notes database (item 508), via the Internet (Rivette'137, col. 11, lines 40-65, fig. 5).

Claim 15,

Rivette'137 teaches:

wherein the at least one document is representative of at least one of: a patent document, a trademark document, a copyright document, a product description document, a license document, a sui generis protection document, a design registration document, a trade secret document, and an opinion document.

(See Rivette'137 Column 39, lines 5-25, discloses the related projects, such as licensing studies, litigation efforts, opinions of counsel (such as patentability, patent validity, and patent infringement studies); (2) scientific and/or engineering related

projects, such as research and development projects; (3) electronic text books, handbooks, user manuals, encyclopedias, and other electronic reference works, including multimedia reference works; (4) auditory and visual documents; (5) virtual library; (6) review course, such as legal bar review course, business review courses, CPA courses, medical review courses, etc.; (7) virtual classrooms; (8) business-related Internet to research; and (9) casual Internet use.)

Claim 16,

Rivette'137 teaches:

a report component, responsive to a user, configured to provide a report listing each annotation in the at least one document, and in visual correspondence thereto a summary of each portion in the at least one document that is associated with each annotation;

(See Rivette'137 Column 39, lines 5-25, discloses the related projects, such as licensing studies, litigation efforts, opinions of counsel (such as patentability, patent validity, and patent infringement studies); (2) scientific and/or engineering related projects, such as research and development projects; (3) electronic text books, handbooks, user manuals, encyclopedias, and other electronic reference works, including multimedia reference works; (4) auditory and visual documents; (5) virtual library; (6) review course, such as legal bar review course, business review courses, CPA courses, medical review courses, etc.; (7) virtual classrooms; (8) business-related Internet to research; and (9) casual Internet use.

Also, see Rivette'137 Fig. 30 Column 29, Lines 55-65, discloses notes database 508 that stores Notes A, B, and C. As described above with reference to FIG. 8, the user interface 504 (FIG. 5) creates, updates, and deletes objects in the Web annotation system 502 preferably using the COM interfaces.)

Also, see Rivette'137 Column 22, Lines 25-40, a notes directory tree or a Web pages directory tree displayed in the notes/Web page directory window 1212, searching for a note or sub-note (as described above with the search button 1230), loading the original Web page (function that shows the user the original version of the Web page).

Also, Rivette'137 further teaches:

> **a map component, responsive to the user, configured to list a summary of each portion the at least one document, each annotation in the at least one document including the at least one annotation, and each reference from the at least one portion of the document, including the at least one reference, wherein each annotation and each reference is visually linked to a corresponding portion listed in the summary.**

(See Rivette'137 Column 22, Lines 25-40, a notes directory tree or a Web pages directory tree displayed in the notes/Web page directory window 1212, searching for a note or sub-note (as described above with the search button 1230), loading the original Web page (function that shows the user the original version of the Web page).

Also, see Rivette'137 Column 7, Lines 45-55, teaches product (CPP) for attaching annotations (or notes and sub-notes) to different data object portions as required by the needs of the user. Using the broadest reasonable interpretation, the Examiner equates the claimed **a map component** as equivalent to attaching annotations (or notes and sub-notes) to different data object portions as required by the needs of the user as taught by Rivette'137.

Claims 17, and 28,

Rivette'137 teaches:

wherein at least one document is an intelligent property document. For example Rivette'137 discloses Rivette'137 invention is applicable to law related project (patentability) (Rivette'137, col.39, lines 10-25).

Claim 26,

the rejection of claims 1 and 25 are fully incorporated, similarly rejected along the same rationale. In addition Rivette'137 teaches:

providing a map listing a summary of each portion in the at least one document, each annotation in the at least one document including the at least one annotation, and each reference from the at least one portion of the document, including the at least one reference, wherein each annotation and each reference is visually linked to a corresponding portion listed in the summary.

(See Rivette'137 at col. 20, lines 15-20, discloses that one or more of notes are grouping in a table, whereby all the notes and sub notes from the table can be links to the appropriate portion of the target web page as selected by user using the OLE standard is based on the Component Object Model (COM), Jscript or DHTML for controlling the web annotating system Fig. 10 item 502.

It is noted that, the OLE standard is based on the Component Object Model (COM), Jscript or Dynamic Hypertext Markup Language (DHTML) is the authoring language used to create documents or pages accessible on the Web, whereby Hyperlinks are a common function of the Internet; A hyperlink is an element in an electronic document that links to another place in the same document or to an entirely different document in the Web environment, (see Rivette'137 at col. 2, lines 20-35), can be reasonably interprets as claimed a schema to identify at least one tag in the at least one element, and logic to determine tags; Since Dynamic Hypertext Markup Language (DHTML) is well known as logically linking element in an electronic document that links to another place in the same document or to an entirely different document in the Web environment using tag schema in collaborating with Component Object Model (COM), Jscript using in Rivette'137 web annotating system.

Claims 18, 19-24 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eintracht** et al. US006687878B1- filed 03/15/1999 [hereinafter Eintracht], in view of **Bly** et al. US005220657A- filed 04/15/1991 [hereinafter Bly].

*Regarding **independent claim 18:***

Eintracht discloses:

> **A computer-implemented system for providing annotated electronic documents, the annotations which are to be applied to the documents being stored in a first data storage, the documents being stored in a second data storage, the first data storage and the second data storage being at least one of physically separate and logically separate,**

(See Eintracht at Fig. 3, and 8 and at Column 15, Line 60→Column 16, Line 10, discloses the annotation Session: includes synchronization of notes and merges the note event information with the server and/or local Notes Database. Also (See Eintracht at Column 2, Lines 15- 55), further discloses a notes client/server notes databases (i.e. notes markup resources), that includes the client software application, which is implemented as a web browser plug-in module. The plug-in contains the user interface for navigating *within the document and for handling the notes*. This allows the annotations are transmitted from the server *independent of the data transmitted that is related to the viewed document*. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each.

This allows the notes merge and the notes are combined with the document data to form a unitary single logical document [e.g., physically separate and logically separate] (See Eintracht at Fig. 3 and 8 and at Column 1, Lines 50-60.)

Also Eintracht further discloses:

said system comprising: (A) at least one merge component, configured: to retrieve the at least one document from a first data storage as document data, to retrieve at least one annotation to be applied to said at least one document from a second data storage as annotation data, said document data including at least one element corresponding to a location of the at least one annotation within said document, wherein the annotation is image data or text, wherein each annotation can be different from every other annotation;

(See Eintracht at Column 3 lines 18-36, discloses notes client operative to locally ***display a representation of a document*** *remotely stored on the server in the document file, the notes client adapted to* ***permit a user to annotate the document with one or more notes****, the notes client operative to simultaneously display the one or more notes associated with the document over* the displayed document such that the document is viewable along with the one or more notes, and synchronization means within the notes clients and the notes server, the synchronization means for updating the notes server with any notes events processed by the notes clients and for updating

the notes client with the results of synchronization updates previously performed by other notes clients since the last synchronization event.

In addition Eintracht at Fig. 3, and 8 and at Column 15, Line 60→Column 16, Line 10, further discloses the annotation Session: includes synchronization of notes and merges the note event information with the server and/or local Notes Database. Also (See Eintracht at Column 2, Lines 15- 55), further discloses the synchronization portion of an Annotation Session is shown in FIG. 8. The process of synchronizing notes is initiated and driven by the user. The user initiates the synchronization process, for example, by pressing a button in the browser application called ` Sync` (step 150) The Notes Client, in response to the button press, functions to prepare a note buffer to send to the Notes Server (step 152). The note buffer contains only the notes that were changed since the time of the previous synchronization event. The time of the previous synchronization event is taken as either the time of the initial request to retrieve the current document or the actual time the user previously pressed the ` sync` button in the Notes Client application. The time of the last synchronization event is always known and stored by the Notes Client application. This time is also transmitted by the Notes Server in the Server Annotation Response Data Structure [In Eintracht Col.15 L60 through Col. 16 L44 and Fig. 8]. This allows the notes merge and the notes are combined with the document data to form a unitary single logical document (See Eintracht at Fig. 3 and 8 and at Column 1, Lines 50-60.))

In addition Eintracht further discloses:

to combine the document data and the annotation data to form a unitary single logical document displaying the annotation embedded seamlessly in the document data at the location;

(See t Fig. 3 and 8 and at Column 1, Lines 50-60, discloses the annotation Session: includes synchronization of notes and allows the notes merge and the notes are combined with the document data to form a unitary single logical document).

Moreover Eintracht further discloses:

B) at least one split component configured: to extract the annotation data and the document data from the single logical document, to update the at least one annotation in the first data storage from the extracted annotation data,

(See Eintracht at Column 3, Lines 28-50, discloses a system for annotating documents comprising a document file and notes database located on the server, each note associated with a particular document, the notes server operative to store the documents in the document file SEPARATELY [or Split] from notes stored in the notes database, the notes server receiving one or more notes associated with a particular document from the one or more notes clients and synchronization means within the notes clients and the notes server, the synchronization means for updating the notes server with any notes events processed by the notes clients and for updating the notes

client with the results of synchronization updates previously performed by other notes clients since the last synchronization event.

Using the broadest reasonable interpretation, the Examiner equates the claimed **split component** as equivalent to store the documents in the document file SEPARATELY from notes stored in the notes database and he synchronization means for updating the notes server with any notes events processed by the notes clients and for updating the notes client with the results of synchronization updates previously performed by other notes clients since the last synchronization event as taught by Eintracht.

This allows independent management associated annotations to a particular document are treated independently from each other- see Eintracht Column 2, Lines 5-15. This interpretation is supported by the Applicant's disclosure, which states, " *the present invention provides for at least one split component, responsive to the marked-up representation, to extract the annotation data and the document data from the marked-up representation*" see the Applicant Specs Page 6, Line 10-12.

Also Eintracht further discloses:

C) at least one version component, configured to at least one of manage a history of changes and to maintain a separate version for the document data and the annotation data to be applied thereto.

(See Eintracht at Column 8, Lines 11-60, discloses the Notes Server 58 functions to keep track of all annotation activity in the Notes Database 60. A convenient

implementation is to use a standard SQL relational database. A Notes Table in the Notes Database 60 is used to reflect the current state of the annotated documents. Transaction history is handled by a Notes Log Table also stored in the Notes Database 60 which is implemented as a transaction log.

Also in Eintracht at Col.3, lines 12-36 and Col. 6, Lines 41-44, further discloses the document and the notes associated with a particular document are stored separately [e.g., maintain a separate version for the document data and the annotation data. Also in Eintracht at Col.4, lines 34-36, and Col. 10, lines 40-46, further discloses a list or history of annotations and the notes table.)

In addition, *Eintracht does not expressly teach the update of the document*, but Eintracht's method allows separately managing and editing the document and Eintracht's method allows synchronization means for updating the notes server with any notes events processed by the notes clients and for updating the notes client with the results of synchronization updates previously performed by other notes clients since the last synchronization event (In Eintracht: Col. 1, lines 53-56 and Col. 6, lines 41-44 and Eintracht at Column 3, Lines 28-50)

However: upon further search and review the newly applied prior art reference of Bly et al. teaches:

to update the at least one document in the second data storage from the extracted document data;

(See Bly at Col. 10, lines 1-8 and Col. 15, lines 36-46, which discloses a method for sharing of the documents between various computers utilizing the server; whereby illustrates in FIG. 1, system 10 includes an Ethernet local area network (LAN) 12, to which a number of user workstations 14, including workstations 14A and 14B, are connected. Also, a large capacity remote storage facility, such as a UNIX minicomputer 24 may be connected to LAN 12. System 10 is a collaborative type system, meaning that it enables users at different workstations 14 to work together in real-time by processing and passing information among one another and storing and retrieving information from storage services 16 and 24 via network 12. The collaborative functions of system 10 could also be centralized in a single main CPU, could be distributed

among processors at the workstations, or could be provided in any combination of centralization and distribution. Similarly, LAN 12 could take any appropriate configuration capable of providing the necessary communications to support collaboration [e.g., *to update the at least one document in the second data storage]).*

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Eintracht, to include a means of updating the at least one document in the second data storage from the extracted document data as taught by Bly, to archive a predictable result of providing a multi-user environment and collaborative type system with a user interface that provides for free and friendly accessibility among different users to shared structured data objects and managing the shared structured data object throughout its life cycle to permit users to concentrate more on the structured data object substance processes and less on the management and production coordination processes [In Bly: Col. 8, lines 31-40]. Also to archive a predictable result of combining the notes with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

Claim 20:

Eintracht discloses:

at least one of the logical single document and the document data is at least one of: XML format, binary format, image data, video data, and audio data.

(See Eintracht at the Abstract, discloses a system for collaborative document annotation whereby notes (i.e. annotations) associated with a document, such as an image or text document, are stored in a notes database on a central notes server.)

Claim 21:

Eintracht discloses:

a schema configured to identify at least one tag in the at least one element, and logic to determine tags for at least one of the document data, the annotation data, and the at least one marked-up representation.

(See Eintracht at Col. 1 L7-13, discloses the SQL Structured Query Language TCP Transport Control Protocol TIFF Tag Image File Format URL Universal Resource Locator WAN Wide Area Network WWW World Wide Web. Also Eintracht further discloses the note anchor field 268 and the mark type 284 [In Eintracht: Fig: 13 and Col. 18 L 51 and Col. 19 L22-35].)

Claim 22:

Eintracht discloses:

wherein the annotation data further includes at least one of: a pre-defined notation, a user-provided text, a user-defined attribute, and at least one reference to at least one of: an element in the document, an element in an other document, a URL, and an other file.

(See Eintracht at Col. 1 L7-13, discloses the SQL Structured Query Language TCP Transport Control Protocol TIFF Tag Image File Format URL Universal Resource Locator WAN Wide Area Network WWW World Wide Web. Also Eintracht further discloses the note anchor field 268 and the marker type 284 [In Eintracht: Fig: 13 and Col. 18 L 51 and Col. 19 L22-35].)

Claim 23:

Eintracht discloses:

the document data is representative of at least one of: a patent document, a trademark document, a copyright document, a product description document, a license document, a sui generis protection document, a design registration document, a trade secret document, and an opinion document.

(See Eintracht at the Abstract, discloses a system for collaborative document annotation whereby notes (i.e. annotations) associated with a document, such as an image or text

document, are stored in a notes database on a central notes server. The documents and associated annotations are treated independently from each other whereby separate data structures are created for the documents and for the associated annotations. Also

Claim 24:

Eintracht discloses:

(D) a report tool, configured to provide, from the single logical document, a report listing a summary of elements in the single logical document and in visual correspondence thereto, each annotation in the single logical document; and (E) a map tool, responsive to the user, configured to list, from the single logical document, a summary of each element in the single logical document, each annotation in the single logical document including the at least one annotation, and each reference in the single logical document including the at least one reference, wherein each annotation and each reference are visually linked to a corresponding element listed in the summary.

(See Eintracht at Fig. 3, and 8 and at Column 15, Line 60→Column 16, Line 10, discloses the annotation Session: includes synchronization of notes and merges the note event information with the server and/or local Notes Database.

Also See Eintracht at Column 2, Lines 15- 55, further discloses a notes client/server notes databases (i.e. notes markup resources), that includes the client software application, which is implemented as a web browser plug-in module. The plug-in contains the user interface for navigating *within the document and for handling the notes*. This allows the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each. This allows the notes merge and the notes are combined with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

Furthermore Eintracht in Col. 2 L40-55, provides a synchronization button which, when pressed by the user, transmits the annotations generated by the user from the client to the server using a particular protocol. In response, the server transmits back an acknowledgement along with any new notes that other clients may have posted since the last synchronization was performed. A user may annotate many documents at the same time by opening several web browser windows. In addition, other clients can annotate either the same document or other documents at the same or a later time. In accordance with the invention, the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each.)

Claim 54:

Eintracht discloses:

an annotation tool, responsive to a user, configured to input annotation data to be applied to the at least one document, including a selection resource to select at least one element of the document data to be annotated, and a mark-up resource to at least one of add and edit annotation data corresponding to the at least one element; an edit tool, responsive to a user, configured to select the at least one element, and to edit the at least one element, including a representation of the at least one selected element, and a representation of the at least one annotation data; and a reference tool, configured to determine at least one reference to the at least one element and at least another element of at least one document, and to enable the at least one reference to be traversed by the user.

(See Eintracht at Fig. 3, and 8 and at Column 15, Line 60→Column 16, Line 10, discloses the annotation Session: includes synchronization of notes and merges the note event information with the server and/or local Notes Database.

Also See Eintracht at Column 2, Lines 15- 55, further discloses a notes client/server notes databases (i.e. notes markup resources), that includes the client software application, which is implemented as a web browser plug-in module. The plug-in contains the user interface for navigating *within the document and for handling the notes*. This allows the annotations are transmitted from the server independent of the

data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each. This allows the notes merge and the notes are combined with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

Furthermore Eintracht in Col. 2 L40-55, provides a synchronization button which, when pressed by the user, transmits the annotations generated by the user from the client to the server using a particular protocol. In response, the server transmits back an acknowledgement along with any new notes that other clients may have posted since the last synchronization was performed. A user may annotate many documents at the same time by opening several web browser windows. In addition, other clients can annotate either the same document or other documents at the same or a later time. In accordance with the invention, the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each.)

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Rivette'137** et al. US006877137B1- filed 12/07/1999 [hereinafter Rivette'137], in view of **Eintracht** et al. US006687878B1- filed 03/15/1999 [hereinafter Eintracht], further in view of **Bly** et al. US005220657A- filed 04/15/1991 [hereinafter Bly].

Claim 7,

Rivette'137 and Eintracht further teach:

at least one split component, responsive to said single logical document, configured: to extract the annotation data and the document data from the single logical document, to update the at least one annotation in the first data storage from the extracted annotation data,

(See Eintracht at Column 3, Lines 35-50, discloses a system a system for annotating documents comprising a document file and notes database located on the server, each note associated with a particular document, the notes server operative to store the documents in the document file SEPARATELY from notes stored in the notes database, the notes server receiving one or more notes associated with a particular document from the one or more notes clients and synchronization means within the notes clients and the notes server, the synchronization means for updating the notes server with any notes events processed by the notes clients and for updating the notes client with the results of synchronization updates previously performed by other notes clients since the last synchronization event.

Using the broadest reasonable interpretation, the Examiner equates the claimed **split component** as equivalent to store the documents in the document file SEPARATELY from notes stored in the notes database and he synchronization means for updating the notes server with any notes events processed by the notes clients and for updating the notes client with the results of synchronization updates previously performed by other notes clients since the last synchronization event as taught by Eintracht.

This allows independent management associated annotations to a particular document are treated independently from each other- see Eintracht Column 2, Lines 5-15. This interpretation is supported by the Applicant's disclosure, which states, " *the present invention provides for at least one split component, responsive to the marked-up representation, to extract the annotation data and the document data from the marked-up representation*" see the Applicant Specs Page 6, Line 10-12.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Rivette'137, to include at least one split component, configured to extract the annotation data and the document data from the single logical document, to update the at least one annotation in the first data storage from the extracted annotation data, as taught by Eintracht, to archive a predictable result of combining the notes with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

In addition, Rivett'137 and Eintracht *do not expressly teach the update of the document*, but Eintracht's method allows separately managing and editing the document and Eintracht's method allows synchronization means for updating the notes server with any notes events processed by the notes clients and for updating the notes client with the results of synchronization updates previously performed by other notes clients since the last synchronization event (In Eintracht: Col. 1, lines 53-56 and Col. 6, lines 41-44 and Eintracht at Column 3, Lines 28-50)

However: upon further search and review the newly applied prior art reference of Bly et al. teaches:

to update the at least one document in the second data storage from the extracted document data;

(See Bly at Col. 10, lines 1-8 and Col. 15, lines 36-46, which discloses a method for sharing of the documents between various computers utilizing the server; whereby illustrates in FIG. 1, system 10 includes an Ethernet local area network (LAN) 12, to which a number of user workstations 14, including workstations 14A and 14B, are connected. Also, a large capacity remote storage facility, such as a UNIX minicomputer 24 may be connected to LAN 12. System 10 is a collaborative type system, meaning that it enables users at different workstations 14 to work together in real-time by processing and passing information among one another and storing and retrieving information from storage services 16 and 24 via network 12. The collaborative functions

of system 10 could also be centralized in a single main CPU, could be distributed among processors at the workstations, or could be provided in any combination of centralization and distribution. Similarly, LAN 12 could take any appropriate configuration capable of providing the necessary communications to support collaboration [e.g., *to update the at least one document in the second data storage]).*

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Eintracht, to include a means of updating the at least one document in the second data storage from the extracted document data as taught by Bly, to archive a predictable result of providing a multi-user environment and collaborative type system with a user interface that provides for free and friendly accessibility among different users to shared structured data objects and managing the shared structured data object throughout its life cycle to permit users to concentrate more on the structured data object substance processes and less on the management and production coordination processes [In Bly: Col. 8, lines 31-40]. Also to archive a predictable result of combining the notes with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

Response to Arguments

It is noted; the prosecution on the merits of this application is reopened on claims 1-3, 6-10, 13-18, 20-28 and 54 considered unpatentable for the reasons indicated above rejections and the followings:

The BPAI decision dated 09/02/2011 "Affirmed in part"; which is stated," Claims 7, 18, 20-24 and 54…We do not, however, ***sustain the Examiner's rejection*** of independent claim 18 … Although Eintracht *effectively extracts annotation and document data from the single logical document (e.g., HTML document) to respectively display the respective document (image) and annotations in the browser*, ***we fail to see how documents stored separately from the annotations would be updated from the extracted document data as claimed*** …We are therefore persuaded that the Examiner erred in rejecting (1) independent claim 18; (2) dependent claims 20-24 and 54 for similar reason; and (3) claim 7 which recites commensurate limitation" [see the BPAI decision dated 09/02/2011 page 8 to page 9].

As recognized by the Examiner, after further search and/or consideration, Rivett'137 and Eintracht do not expressly teach *the update of the document*, ***But:*** Eintracht's method allows separately managing and editing the document and Eintracht's method allows synchronization means for *updating the notes server with any notes events processed by the notes clients* and for updating the notes client with the results of synchronization updates previously performed by other notes clients since the

last synchronization event (In Eintracht: Col. 1, lines 53-56 and Col. 6, lines 41-44 and Eintracht at Column 3, Lines 28-50)

However: upon further search and review the newly applied prior art reference of Bly et al. teaches: ***to update the at least one document in the second data storage from the extracted document data;*** [In Bly: at Col. 10, lines 1-8 and Col. 15, lines 36-46, which discloses a method for sharing of the documents between various computers utilizing the server; whereby illustrates in FIG. 1, system 10 includes an Ethernet local area network (LAN) 12, to which a number of user workstations 14, including workstations 14A and 14B, are connected. Also, a large capacity remote storage facility, such as a UNIX minicomputer 24 may be connected to LAN 12. System 10 is a collaborative type system, meaning that it enables users at different workstations 14 to work together in real-time by processing and passing information among one another and storing and retrieving information from storage services 16 and 24 via network 12. The collaborative functions of system 10 could also be centralized in a single main CPU, could be distributed among processors at the workstations, or could be provided in any combination of centralization and distribution. Similarly, LAN 12 could take any appropriate configuration capable of providing the necessary communications to support collaboration [e.g., *to update the at least one document in the second data storage]).*

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Eintracht, to include a means of updating the at least one document in the second data storage from the extracted document data as taught by Bly, to archive a predictable result of providing a multi-user environment and collaborative type system with a user interface that provides for free and friendly accessibility among different users to shared structured data objects and managing the shared structured data object throughout its life cycle to permit users to concentrate more on the structured data object substance processes and less on the management and production coordination processes [In Bly: Col. 8, lines 31-40]. Also to archive a predictable result of combining the notes with the document data to form a unitary single logical document - See Eintracht at Fig. 3, and 8 and at Column 1, Lines 50-60.

Thus, for at least all the above evidence, therefore the Examiner respectfully maintains the rejection of claims 1-3, 6-10, 13-18, 20-28 and 54 at this time.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to QUOC A. TRAN whose telephone number is (571)272-8664. The examiner can normally be reached on Mon through Fri 8AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cesar Paula can be reached on (571)272-4128. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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